

Express Mail No. EV 666 270 150 US
Application No. 10/670,962
Attorney Docket No. 49942-287485

REMARKS

Applicants submit this Response in response to a Non-final Office Action mailed on June 14, 2005. Applicants have amended claims 1, 2, 4, 10, 14-16, 18, 19, 21, 27, and 28 and deleted claims 5, 9, 13, 22, 26, and 31. Thus, claims 1-4, 6-8, 10-12, 14-21, 23-25, and 27-30 are pending and ready for further action on the merits. In making these amendments, Applicants have added no new matter. Support for the amendments above can be found in the specification and claims as filed. Reconsideration of the pending claims is respectfully requested in view of the foregoing amendments and the following remarks.

A. Response to Specification Objections

The Office Action objects to the abstract of the disclosure and the title asserting that they are not sufficiently descriptive. Applicants respectfully disagree; however, in an effort to expedite prosecution, Applicants have amended the abstract and title pursuant to the Office Action's request. Accordingly, Applicants respectfully requests that the Examiner remove the objection to the abstract and the title.

B. Response to Claim Objections

The Office Action objects to claims 7-9 and 24-26 under 37 C.F.R. § 1.75(c) for not further limiting the subject matter of a previous claim. Applicants have amended claims 1 and 18 to include the limitation of claims 9 and 26, respectively, and have deleted claims 9 and 26 for that reason. Applicants respectfully assert that claims 7-8 and 24-25 further limit the

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subject matter of the previous claim. For example, claim 1 claims an apparatus comprising a first surface “adapted to be coupled with a frame,” and claim 7 further limits the first surface by reciting that the frame to which the first surface is adapted to be coupled comprises “a vinyl door frame.” Applicants respectfully assert that a surface adapted to be coupled to a particular frame (in the example, a vinyl door frame) is more limited in subject matter than a surface adapted to be coupled to a frame generally. The same reasoning holds for claims 8, 24, and 25. Therefore, Applicants respectfully request that the Examiner remove the objection to claims 7-8 and 24-25.

C. Response to Claim Rejections Under 35 USC 112 (Claims 4, 5, 10-17, and 22)

The Office Action rejects claims 4, 5, 10-17, and 22 under 35 U.S.C. § 112, second paragraph, as indefinite. Applicants have canceled claims 5 and 22 rendering the rejection moot with respect to those claims.

Applicants have amended claim 4. Applicants respectfully submit that claim 4, prior to amendment, conformed to 35 U.S.C. § 112. However, in an effort to expedite prosecution, Applicants have amended claim 4 to recite, “[t]he apparatus of claim 1, wherein the channel is adapted to secure the nailing fin.” Applicants believe this amendment obviates the Office Action’s rejection.

Applicants have amended claim 10 in accordance with the Examiner’s suggestion in the Office Action. Thus, Applicants believe that the rejection over this claim and claims 11-16, which depend from claim 10, has been obviated. Accordingly, Applicants respectfully assert

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that claims 4 and 10-17, as amended, comply with 35 U.S.C. § 112, second paragraph, and respectfully request that the Examiner remove the rejection of claims 4 and 10-17 under 35 U.S.C. § 112, second paragraph.

D. Response to Claim Rejections Under 35 USC 102 (Claims 1-10 and 13-17)

Claims 1-10 and 13-17 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,511,285 to Bush et al. (hereinafter “Bush”).

Claims 1-3 and 5-9 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,732,442 to Haggard (hereinafter “Haggard”).

Applicants have amended claims 1 and 10 to specify that the fin recited is a “nailing fin.” Neither Bush nor Haggard discloses all elements of claim 1 or 10, as amended. For example, neither disclose “a channel adapted to be coupled with a nailing fin” as recited in claim 1, as amended, or “a channel adapted to be coupled with the nailing fin” as recited in claim 10, as amended (emphasis added). Claims 2-9 depend from claim 1, and claims 14-17 depend from claim 13. Accordingly, these claims include the recited “nailing fin” which is not disclosed by either Bush or Haggard.

Thus, withdrawal of the rejection of claims 1-10 and 13-17 under 35 U.S.C. § 102(b) is warranted and respectfully requested.

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E. Response to Claim Rejections Under 35 USC 103 (Claims 1-10 and 13-17, Claim 12)

Claims 1-10 and 13-17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush in view of U.S. Patent No. 4,815,246 to Haas (hereinafter, "Haas").

Claim 12 has been rejected under 35 USC 103(a) as being unpatentable over Bush in view of U.S. Patent No. 4,780,998 to Knapp (hereinafter, "Knapp").

The Office Action states that "Haas discloses a vinyl door frame 14, 16, 18 having a nailing fin (not numbered, but shown in figure 2). Office Action at 5. Similarly, the Office Action also states that "Knapp discloses a vinyl window frame 60 having a nailing fin 66." Id. The Office Action further states that "[i]t would have been obvious to one of ordinary skill in the art to provide the vinyl window frame of Knapp with handles, as taught by Bush et al., to increase the ease with which the door frame can be moved." Id. Applicants respectfully disagree.

Claim 1 has been amended to include the limitation of claim 9 (now deleted).

Likewise, claim 10 has been amended to include the limitation of claim 13 (now deleted).

Claim 12 depends from claim 10.

Applicants assert that a proper *prima facie* case of obviousness has not been established. To establish a proper *prima facie* case of obviousness, three basic criteria must be met:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference

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or to combine reference teachings;

- 2) There must be a reasonable expectation of success; and
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2142 and 2143.

Applicants respectfully assert that none of these criteria are satisfied. For example, the prior art references (or references when combined) do not teach or suggest all the claim limitations. The rejection under 35 U.S.C. § 103(a) is improper because neither Haas nor Bush teaches or suggests, singularly or in combination, all the claim elements of independent claims 1 or 13, as amended.

For example, neither Haas nor Bush teaches or suggests a “channel adapted to be coupled with a nailing fin of [a] frame”, as recited in claim 1. Moreover, neither Haas nor Bush teaches or suggests “a handle comprising … a channel … adapted to be coupled with [a] nailing fin,” as recited in claim 10. Thus, as Haas and Bush do not teach or suggest all claim limitations in claim 1 or claim 10, Applicants respectfully request that the Examiner remove the rejection of claim 1 and claim 10 under 35 U.S.C. § 103(a). Because claims 2-9 and claims 12 and 14-17 depend from claim 1 and claim 10, respectively, Applicants respectfully submit that these claims also cannot be rendered obvious by the cited references. Accordingly, withdrawal of the rejection of claims 2-9 and claims 12, 14-17 is warranted and respectfully requested.

Applicants also respectfully assert that the first two criteria to establish a proper *prima*

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facie case of obviousness have not been satisfied. In order to establish *a prima facie* case of obviousness, there must be some suggestion or motivation to combine the teachings of the references and there must be a reasonable expectation of success. See, e.g., MPEP § 2143.

In this regard, Applicant respectfully assert that Bush teaches away from the apparatus and systems claims in claims 1-10 and 12, 14-17. The handle shown in Bush teaches, for example, significant prior alteration of the target frame. The handle shown in Bush requires considerably more structural elements and significant prior alteration of the target frame (e.g., with a fastening bracket, shown as C in the figure in Bush cited in the Office Action, figure 3), among other things. The apparatus and system claimed in the present application offers a more convenient solution (see, for example, Figure 1 and Figure 6 of the present application). This same reasoning applies to the other rejections under 35 U.S.C. § 103 made in the Office Action as well. For this reason also, Applicants respectfully submit that the rejection should be withdrawn.

F. **Response to Claim Rejections Under 35 USC 103 (Claims 18-22 and 24-26, claims 18-20 and 22-26)**

Claims 18-26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bush as applied to claims 1-10 and 13-17. The Office Action goes on to address claims 18-22 and 24-26 in that vein. However, the Office Action fails to address claim 23 in relation to claims 1-10 and 13-17. Accordingly, Applicants respectfully assert that claim 23 is allowable.

The Office Action rejects claims 18-22 and 24-26 under 35 U.S.C. § 103(a) as

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unpatentable over Bush, as applied to claims 1-10 and 13-17 in the Office Action. Moreover, the Office Action rejects claims 18-20 and 22-26 under 35 U.S.C. § 103(a) as unpatentable over Haggard as applied to claims 1-3 and 5-9. The Office Action states that although Bush and Haggard fail to disclose the method steps set forth in claims 18-22 and 24-26 and claims 18-20 and 22-26, respectively, the use of the apparatus disclosed by Bush and Haggard would inherently lead to the method steps set forth in claims 18-22 and 24-26 and claims 18-20 and 22-26, respectively.

Claim 18 has been amended to specify that “providing a channel disposed proximate the flange,” as claimed, involves a channel “adapted to be coupled with a nailing fin of the frame” (emphasis added). As discussed above, neither Bush nor Haggard discloses “providing a channel disposed proximate the flange, the channel adapted to be coupled with a nailing fin of the frame.” Thus, neither Bush nor Haggard teaches or suggests all limitations of claim 18 as is required and discussed above. Applicants respectfully request that the Examiner remove the rejection of claim 18. Claims 22 and 26 have been deleted. Claims 19-21 and 23-25 depend from claim 18, and Applicants respectfully request that the Examiner to remove the rejection of claims 19-21 and 23-25 for at least the same reason.

G. Response to Claim Rejections Under 35 USC 103 (Claims 27, 28, and 31)

The Office Action rejects claims 27, 28, and 31 under 35 U.S.C. § 103(a) as being unpatentable over Bush as applied to claims 1-10 and 13-17 in the Office Action. Claim 27 has been amended to include “coupling the channel with a nailing fin of the frame” (emphasis

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added.). Bush does not teach or suggest, for example, “coupling the channel with a nailing fin of the frame.” Thus, Bush does not teach or suggest all limitations of claim 27 as is required and discussed above. Applicants respectfully request that the Examiner remove the rejection of claim 27. Claims 28 and 31 depend from claim 27, and Applicants respectfully request that the Examiner remove the rejection of claims 27, 28, and 31 for at least the same reason.

H. Response to Claim Rejections Under 35 USC 103 (Claims 29 and 30)

The Office Action rejects claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Bush in view of Haas as applied to claim 11. The Office Action also rejects claim 30 under 35 U.S.C. § 103(a) as being unpatentable over Bush in view of Knapp as applied to claim 12. The Office Action states that although Bush fails to disclose the method steps set forth in claim 29 and claim 30, the use of the apparatus disclosed by Bush in view of Haas and in view of Knapp would inherently lead to the method steps set forth in claims 29 and 30, respectively.

Claims 29 and 30 depend from claim 27. Claim 27 has been amended to include “coupling the channel with a nailing fin of the frame” (emphasis added). As discussed above, Bush does not teach or suggest “coupling the channel with a nailing fin of the frame.” Likewise, neither Haas nor Knapp teaches or suggests, either singularly or in combination, “coupling the channel with a nailing fin of the frame.” Accordingly, Applicants respectfully request that the Examiner remove the rejection of claims 29 and 30 for at least the reasons set forth above.

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Again, Applicants respectfully assert that Bush teaches away from the products and processes claimed in that, for example, the handle shown in Bush teaches, for example, significant prior alteration of the target frame. The handle shown in Bush requires considerably more structural elements and significant prior alteration of the target frame (e.g., with a fastening bracket, shown as C in the figure in Bush cited in the Office Action, figure 3), among other things. The apparatus and system claimed in the present application offers a much more convenient solution (see, for example, Figure 1 and Figure 6 of the present application).

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CONCLUSION

With the above amendments and remarks, Applicants believe that all objections and/or rejections have been obviated. Thus, each of the claims remaining in the application is in condition for immediate allowance. A passage of the instant invention to allowance is earnestly solicited.

Applicants believe that no fee is necessary, however, should a fee be deemed to be necessary, the Commissioner is hereby authorized to charge any fees required by this action or any future action to Deposit Account No. 50-1196.

Should the Examiner have any questions relating to the instant application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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